

## REMARKS

Claims 16-35 remain in this application. Claims 1-15 have been cancelled without prejudice to their subsequent reinstatement. Claims 16-35 have been added. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

### 35 U.S.C. §102(b) Rejection – Taniguchi

The Examiner has rejected former claims 12-13 under 35 U.S.C. §102(b) as being anticipated by Japanese Patent No. 10-335,195 issued to Taniguchi et al. (hereinafter “Taniguchi”). These claims have been cancelled. The Applicants respectfully submit that the present claims are allowable over Taniguchi.

Claim 16 recites a method comprising “*applying a photoresist layer to a first substrate to protect an **active portion having a first circuit**; etching a portion of the first substrate that is not protected by the photoresist layer; bonding the first substrate to a second substrate after said etching; and thinning the first substrate to remove an unsupported bevel portion of the first substrate*”.

Taniguchi does not teach or suggest these limitations. In particular, Taniguchi does not teach or suggest applying a photoresist layer to a substrate to protect an **active portion having a first circuit**.

As understood by Applicants, Taniguchi discusses manufacturing lamination substrates, such as, silicon-on-silicon substrates and silicon on insulator (SOI) substrates. Microelectronic devices may presumably **subsequently** be formed in such silicon-on-silicon and SOI substrates **after the bonding process**. However, as understood by

Applicants, there is absolutely no teaching or reasonable suggestion in Taniguchi that the so-called wafer for barrier layers (1) have an active portion having a first circuit.

In contrast, the claimed method recites at least “*applying a photoresist layer to a first substrate to protect an active portion having a first circuit*”. As discussed in the patent application, one embodiment or more embodiments of such a method may be useful for forming Three-Dimensional Structure (3DS) integrated circuits (ICs) that allow physical separation of circuits and control logic onto different layers such that each layer may be separately optimized. See e.g., page 2 of the patent application. In contrast to the substrates of Taniguchi, the substrates of the 3DS ICs may have circuits or other active components or portions.

Anticipation under 35 U.S.C. Section 102 requires every element of the claimed invention be identically shown in a single prior art reference. The Federal Circuit has indicated that the standard for measuring lack of novelty by anticipation is strict identity. “*For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference.*” In *Re Bond*, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 16 is believed to be allowable over Taniguchi. Claims 17-25 depend from claim 16 and are believed to be allowable therefor, as well as for the recitations separately set forth in each of these claims.

Independent claims 26 and 32, and their dependent claims, are believed to be allowable for at least reasons similar to those discussed above for claim 16.

### **35 U.S.C. §102(e) Rejection – MacNamara**

The Examiner has rejected claims 1-4, 6-9 and 11-15 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,841,848 issued to MacNamara et al. (hereinafter

“MacNamara”). These claims have been cancelled. The Applicants respectfully submit that the present claims are allowable over MacNamara.

Claim 16 recites a method comprising “*applying a photoresist layer to a first substrate to protect an **active portion having a first circuit**; etching a portion of the first substrate that is not protected by the photoresist layer; bonding the first substrate to a second substrate after said etching; and thinning the first substrate to remove an unsupported bevel portion of the first substrate*”.

MacNamara does not teach or suggest these limitations. In particular, MacNamara does not teach or suggest applying a photoresist layer to a substrate to protect an **active portion having a first circuit**.

As understood by Applicants, MacNamara discusses that the micro-mirrors are formed after bonding the wafers and machining the device wafer 9 to the desired thickness. See e.g., column 10, lines 5-21. In any event, MacNamara does not appear to teach or reasonably suggest that the device wafer have an active portion and a circuit prior to the bonding process.

Anticipation under 35 U.S.C. Section 102 requires every element of the claimed invention be identically shown in a single prior art reference. The Federal Circuit has indicated that the standard for measuring lack of novelty by anticipation is strict identity. “*For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference.*” In *Re Bond*, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 16 is believed to be allowable over MacNamara. Claims 17-25 depend from claim 16 and are believed to be allowable therefor, as well as for the recitations separately set forth in each of these claims.

Independent claims 26 and 32, and their dependent claims, are believed to be allowable for at least reasons similar to those discussed above for claim 16.

### **35 U.S.C. §103(a) Rejection - MacNamara**

The Examiner has rejected claims 5 and 10 under 35 U.S.C. §103(a) as being unpatentable over 6,841,848 issued to MacNamara.

As discussed above, the pertinent independent claims are believed to be allowable over MacNamara. Applicants therefore do not address the propriety of the rejections of these dependent claims at this time.

### **Conclusion**

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

### **Request For Telephone Interview**

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

### **Request For An Extension Of Time**

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

### **Charge Our Deposit Account**

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 7/20/05

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